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EXAMINER	
CARLSON, JEFFREY D	

ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/033,401	ROSENBERG, SCOTT A.	
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 October 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,7-10,12,13,20,21,23,27-33 and 35-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,7-10,12,13,20,21,23,27-33 and 35-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/12/09*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the paper(s) filed 10/6/2009.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. **Claims 1, 7-10, 12, 13, 20, 21, 23, 27-28, 31, 33, 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US2001/049820) in view of Official Notice.**

4. Regarding claims 1, 20, 21, 27-28, 33, 35-36, Barton teaches a DVR (connected to a display device of a TV) with software that enables a user to select (during a first mode where figure 2's menu/index/list of pre-recorded programs is offered on the screen) a program for requested playback. Barton teaches a bookending function which can insert and play advertising before the user-selected, pre-recorded program is played. The bookending function also may play advertising after the program playback [abstract, 0014]. Both the beginning and end of the requested program content are taken to represent detections of a mode change and trigger obtaining/determination of an appropriate advertisement. Regarding the claimed feature that the advertising is displayed simultaneously with the video of the modes, it is unstated in Barton whether or not there is any simultaneous display of 1st mode (the index/menu) with the ad or

whether or not there is any simultaneous display of the ad with the 2nd mode (the requested program). However it is clear that Barton teaches a sequence of 1st mode (index/menu),…advertising…2nd mode (the requested program). Official Notice is taken that it was well known to enhance video content by including visual transitions between portions of video content. One typical video transition has been traditionally referred to as a "wipe" – much as applicant describes in his figure 3(d) and referred to as a "wipe" in the instant specification and current claims. A long time ago George Lucas used this technique heavily in the Star Wars original trilogy (1977+) whereby a first scene (first video mode) was wiped over by a second scene (second video mode). In the middle stages of this wipe, both scenes were simultaneously on the screen but without overlap. One of ordinary skill has understood that video transitions such as a wipe (and others such as dissolve, fade, blinds, etc.,) help smooth or create fanciful transitions between different video portions. It would have been obvious to one of ordinary skill at the time of the invention to have provided any of such well known transitions including vertical or horizontal wipes between the "modes" of Barton (menu transitions into the ad; the ad transitions into the selected program). By doing such a wipe, Barton's index would be displayed simultaneously on the screen as the ad, but would eventually be wiped off the screen by the ad. Likewise, the end of the advertising content would be wiped off the screen with the start of the selected program.

5. Regarding claims 7-10, 13, Barton teaches that the ads are pre-stored on the device and that they can be selected on the basis of the viewer's preferences and personal information [0015]. This is taken to provide a real-time and dynamic selection

of ads based upon previously collected user information. Claim 10's "context information" is quite broad and could be met by virtually any information used for the bookend feature: the context that there is a transition to the start of a requested program, the context that there is a transition from the end a requested program, the context that the ads are targeted to the audience that the viewer is a part of [0015], the context of the genre, etc. The bookend programming/functionality [fig 9: 904] is taken to provide an ad placement engine.

6. Regarding claim 12, while any moving video content can be taken to be animation (i.e. simple motion), Official Notice is taken that TV commercials have for decades included cartoon animation, such as the Snap, Crackle and Pop characters for Kellogg's Rice Krispies ™. It would have been obvious to one of ordinary skill at the time of the invention to have provided at least some of the advertisements of Barton as animations in a manner as well known.

7. Regarding claim 23, Official Notice is taken that some TV advertising has for years included a still image (for example a textual ad for a business which textually lists the name, address and phone number of the business) which is rendered as video frames for a period of time long enough for a viewer to read the pertinent information. Another example is the ubiquitous FBI warning message text screen that has accompanied purchased/rented movies for many years before applicant's filing date. It would have been obvious to one of ordinary skill at the time of the invention to have inserted any such type of advertising, including a replicated still frame.

8. Regarding claim 31, Barton teaches downloading of the ads from a server [0049]. They are then stored obtained from memory when needed for display.

9. **Claims 29, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US2001/049820) in view of Official Notice as above, and further in view of Borchardt et al (US5272525).**

10. Regarding claims 29, 30, Barton does not specify how the display device is connected to the DVR, however Borchardt et al describes typical connections between video sources hardware and TV displays as being wired [1:20-27] or as wireless transmissions [abstract]. It would have been obvious to one of ordinary skill at the time of the invention to have connected the DVR hardware of Barton in any such known manner.

11. **Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US2001/049820) in view of Official Notice as above, and further in view of Klug (US2003/0195797).**

12. Regarding claim 32, Barton teaches targeting advertising to a user's preferences such as types of programming (e.g. sci-fi), but does not explicitly teach the use of a program title. Klug teaches targeted advertising to television programming and teaches that the programs title can be used as a basis to determine appropriate advertising [0032]. It would have been obvious to one of ordinary skill at the time of the invention to

have used such title-based targeting with the invention of Barton in order to provide relevant advertising to the viewer.

13. **Claims 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US2001/049820) in view of Official Notice as above, and further in view of Nihei (US7337456).**

14. Regarding claims 37, 38, Barton does not appear to teach advertising based on time or location. However Barton does teach that the DVR can insert advertising that is targeted to that particular user (preferences, gender, age, hobbies, for examples) and that this targeted nature of the advertising enables the DVR provider to charge higher prices to advertisers [0048]. Nihei teaches a system which dynamically selects and presents advertising to a user, the advertising being chosen according to time and location. The advertising metadata which includes parameters of location and time (such as sales events and business hours) is compared to the user's context (time, location) and appropriately targeted advertising is chosen to show to that specific user [8/38-56; 13/25-30; 14/4-9, 39-47]. Nihei teaches that this leads to ads of interest to the user, provides effective ads that suit the circumstances of the individual user, increases probability of purchases and provides greater sales opportunities [16/41-63]. Therefore these benefits achieved by targeting advertising to time and location (i.e. advertising a burger restaurant's sales during business hours of that particular local restaurant location) would have been obvious to have provided with that of Barton, thereby offering increasing the effectiveness of (and ability to charge higher rates for) the single-user

targeting sought by Barton. It would have been obvious to one of ordinary skill at the time of the invention to have determined the location of Barton using any well accepted techniques including a simple questionnaire to develop a profile that includes location, hobbies, gender, age, etc.

Response to Arguments

15. Applicant appears to accept that "wipes" (side-to-side, without overlap) are video transitions well known in the prior art at the time of the invention. Applicant appears to argue that the wipes referred to in the Star Wars (1977+) movies are wipes between scenes of the movie and not wipes that transition between a program index and an advertisement and then between the advertisement and a requested program. Given that the wipe was a well known video transition technique, it would have been obvious to one of ordinary skill at the time of the invention to have used such a wipe to transition (side-to-side without overlapping) between the video modes of Barton – that is, a wipe from the program index to the ad, THEN a wipe from the ad to the requested program. In essence, it would have been obvious to one of ordinary skill at the time of the invention to have used any type of known transition (horizontal wipe, vertical wipe, fade, dissolve, 'blinds', etc.,) between the video modes of Barton, even when Star Wars was limited to transition between scenes of the same program/movie content.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/
Primary Examiner, Art Unit 3622

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jdc